

REMARKS/ARGUMENTS

Claims 12, 14, 16 and 18-21 remain in this application.

In response to the Office Action of July 27, 2007, Applicant requests re-examination and reconsideration of this application for patent pursuant to 35 U.S.C. 132.

Rejection under 35 USC 103(a)

In the Action, claims 12,14-16 and 18-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Koch, III, US Patent 5,299,720, in view of Erlich, US Patent 6,206,547, and Clark, US Patent 6,572,244.

The Examiner indicates the following claim limitations as being met by Koch within the embodiment of Figures 8-10, stating that Koch provides what is considered a safety handle capable of being used for temporary attachment to a pier piling for use by passengers during boarding and exiting a boat, said safety handle comprising a base member 4 constructed of a relatively flexible sheet of material, said base member further defined as having a front surface 8 and a back surface bounded by a top edge and a bottom edge with a first and second side edge, a handgrip 3 secured to said back surface, said handgrip formed with a receptacle 5a, said receptacle sized so as to be capable of receiving a light

stick, a pair of straps 9 connected to said base member, one said strap adapted to extend around said piling, as claimed.

The Applicant respectfully disagrees with the Examiners characterization of the Koch device. Figures 8-10 are detailed by Koch in Column 3 starting at line 60 where the handle and friction connector 1 is constructed and arranged as an attachment to a drink container, utility container, or the like, and does not cite a piling. Koch combines his handle for use in coupling to a tubular bike frame or boat railing. The Koch handle could not operate as a receptacle for a light stick without modification. Modification of the Koch handle would make it non-operative for its intended purpose, namely, securement to tubular bike rail or boat railing. To use the Koch device has a handgrip in entering or exiting a boat would be most dangerous as the split handle could injure a person. The purpose of the Applicant's invention is to provide a safety device for ingress and egress to a boat so that the handle must be smooth, not have a design for securement to a tubular pipe. Further, the straps of Koch are not adapted for securement to a weathered piling, but rather to a well formed drink container, utility container, or the like. A strap adapted to such a surface includes a set of shapes, sizes and material properties such as elasticity, corrosion resistance, etc... which is very clearly

different than a strap adapted to conform to a small, well formed drink container, utility container, or the like.

The Examiner states that Koch provides the claimed invention except (1) said front surface adapted to contact an including integrally formed rigid protrusions designed to temporarily prohibit movement of said base member, as claimed; (2) said receptacle made of a material permitting light to shine through, wherein said base member and said hand grip are plastic, and said hand grip receptacle being translucent, as claimed; (3) said base member is wood; and (4) said strap is of a length sufficient to encircle said piling between 6 inches and 20 inches.

The Examiner states that regarding (1), Koch discloses the handle for engagement with a metal surface. The Examiner then goes on to cite that **Kobdish** teaches "rigid projections 26 for engagement with metal surfaces for improved clamping/attachment purposes", and that it would have been obvious to include rigid projections on the device of Koch for the purpose of improving attachment of the device, particularly to metal surfaces. There are several problems with this. To begin with, the Examiner rejected the claim under 35 U.S.C. § 103(a) as being unpatentable over Koch, III, US Patent 5,299,720, in view of Erlich, US Patent 6,206,547, and Clark, US Patent 6,572,244. Reference to "Kobdish" is apparently copied from a previous office action, and as such,

does not address the newly amended claims, but rather the prior claims. Kobdish, (presumably US Patent 6,186,383. as cited in the last office action,) may or may not be part of the 103 rejection, but with no motivation to combine, the Applicant cannot guess what grounds on which the Examiner intended to form a rejection with respect to modification of Koch by some combination Kobdish, Erlich and Clark.

The Applicant respectfully disagrees with the Examiner's determination that the invention as claimed is obvious. In order for an Examiner to establish a prima facie case of obviousness, three basic criteria must be met (MPEP 2142). First there must be some suggestion or motivation, either in the references themselves or the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references) when combined must teach or suggest all of the claimed limitations.

The Applicant wishes to illustrate that the Applicant's protrusions are for engaging a wood piling. The piling is very clearly included as a limitation in the claimed invention. The Applicant is not attempting to engage any metal device as set forth in Koch or Kobdish. Wood pilings used in the boating industry are subject to extreme weather conditions resulting in cracking,

splintering, worm growth, and so forth. All of which makes for a slippery surface when wetted. The use of a material that is capable of passing light has no purpose with Koch or Kobdish and would not add any safety provision to their use of "handles". However, the use of a material capable of passing light has a very important safety factor with the Applicant, the placement of the handle on a vertical piling provides an illuminated handle that would otherwise be most dangerous to produce. Even if the industry made a chemiluminescent light stick that could fit in the handle of Koch, which it does not, placement in an open position would be even more dangerous for any individual to grasp as they could pull the stick away from the handle.

The preamble of both claims 12 and 20 recite a safety handle for temporary attachment to a pier piling for use by passengers during boarding and disembarking a boat. It has been held that the preamble can serve to limit claim scope if it recites essential structure or steps, or it is necessary to give life, meaning, and vitality to the claim. Catalina Mkrg. Int'l, Inc. v. Coolsavings Com. Inc. 289 F.3d 801, 803, 808 (Fed. Cir. 2002), see also Piney Bowes, Inc. v Hewlett-Packard, Co. 182 F.3d 1298, 1305 (Fed. Cir. 1999). Applicants contend that the boat is not merely a statement of intended use. In this case, the boat is an essential structure which is necessary to give meaning to the body of claims 12 and 20.

Thus, this element must be evaluated and considered just like any other limitation of the claim to determine whether the claim distinguishes over the prior art since it sets definite boundaries on the patent protection sought. As noted above, the pier is very clearly cited as a limitation within the claim, and therefore must also be evaluated and considered in the rejection.

The Examiner states that regarding (2), Erlich provides an example of a lighted handle with a receptacle there in for the purpose of allowing the user of the device to see under, dark conditions. Regarding the limitation of an aperture placed in one of the legs, Clark provides teaching of a light stick receiving in an aperture, allowing for insertion. It would have been obvious at the time the invention was made for one skilled in the art to modify the design of Koch to include such a limitation, so that one or more of the bridge parts 3 would provide a light source allowing a user to see under dark conditions. Regarding the aperture, such a limitation is obvious so as to allow for insertion of the light stick.

The Applicant respectfully disagrees with the Examiner's determination that the invention as claimed is obvious. Again, in order for an Examiner to establish a prima facie case of obviousness, three basic criteria must be met (MPEP 2142). First there must be some suggestion or motivation, either in the

references themselves or the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references) when combined must teach or suggest all of the claimed limitations.

The Examiner states that regarding (3) and (4), it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device in these ways, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

The Applicant respectfully disagrees with the Examiner's determination that the invention as claimed is obvious. Again, in order for an Examiner to establish a *prima facie* case of obviousness, three basic criteria must be met (MPEP 2142). First there must be some suggestion or motivation, either in the references themselves or the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references) when combined must teach or suggest all of the claimed

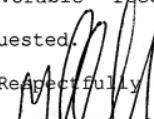
limitations. The Applicant respectfully requests the Examiner to reconsider the rejection as the Koch, Kobdish, Clark and Erlich devices are not directed for use with pilings so the material of design does make a difference. The Koch device was designed as a handle for carrying bottles and the like containers. Kobdish refers to a fixing a flashlight to a metallic bar on a bicycle frame. The Erlich reference is to a submerged pool light with an external power supply, and the Clark reference is to a novelty device for food presentation. Unlike the instantly claimed handle, the teachings of Kobdish, Erlich, Clark do not meet the limitation of illuminating the handle, but instead are specifically designed to project light beyond the respective devices so as to provide lighting to surrounding objects as a primary function of their use. Powerful lights, light projecting/directing sources as indicated by Kobdish, Erlich and Clark would be dangerous in the instant application as they might cause a boarding passenger temporary blindness due to excessive or externally directed light exposure. Furthermore, this diverse array of exceedingly dissimilar items gathered from many varied arts would not have been obvious to one having ordinary skill in the art at the time the invention, and there is no legitimate motivation to combine them, especially for illumination of the handgrip at night. The instant handle must address vertical placement of the hand grip necessary

for an individual attempting to enter a boat. The teachings of Koch, Kobdish, Erlich and Clark, do not include a handle which is structurally capable of surviving the expected substantial applied stresses during boarding, such as forces caused by weight and movement of a boat on water.

Therefore, Applicants respectfully submit that the prior art references when combined fail to teach or suggest all of the claimed limitations. Moreover, there is no motivation for combining the dissimilar devices of Koch, Kobdish, Erlich and Clark for the reasons delineated above. Even if there were a reason to combine, the result would not be a stationary handle for mounting on an immovable piling for stabilizing movement onto or off of a boat.

SUMMARY

In light of the foregoing remarks, it is respectfully submitted that the Examiner will now find the claims of the application allowable. Favorable reconsideration of the application is courteously requested.

Respectfully submitted,

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10/26/07

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